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Supreme Court of the United States

October Term, 1944

No. 148

THE AIROLITE COMPANY and THE VENTILOUVRE
COMPANY, INC.,

Petitioners,

against

HARRY W. FIEDLER, doing business as AIR CON-
DITIONING UTILITIES COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT

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New York, N. Y.
June 18, 1945



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TO THE HONORABLE THE CHIEF JUSTICES OF THE SUPREME
COURT OF THE UNITED STATES:

Summary Statement of Matter Involved.

This case is for patent infringement and unfair competition.

The petitioners, The Airolite Company and its wholly owned subsidiary The Ventilouvre Company, Inc., have been in the business of making and selling ventilating louvers since 1929. Their product is, used in many high

class buildings throughout the country, as shown by the very significant list of hotels, hospitals, universities and colleges, armories, apartments, nurses homes, Y. M. C. A.'s and Y. W. C. A.'s, bank buildings, clubs, office and industrial buildings, theatres, churches, dormitories, schools, steamships and boats, bomb shelters, and miscellaneous institutions, appearing on page 148 of the Record. Their standing with the public and the trade was of the highest. Their president Mr. Murray testified that the reputation of his Company and its products with the architects and the public was "our most valuable and important asset." (Record page 38.) This was not denied or in any way limited by respondent.

For the petitioners two witnesses were called, Mr. Murray, President of the petitioners, and the respondent Harry W. Fiedler, doing business under the high sounding name of Air Conditioning Utilities Company. For the respondent the only witness was a mechanical engineer Goodman J. Harris who had been in the employ of respondent for about three months before he testified and who had had no experience in this field prior to that time. His testimony was wholly from the standpoint of the patent expert, now fortunately appearing in our courts less frequently than formerly was the case.

Petitioners' structure which is the basis of the infringement side of the case is shown by Plaintiffs' Exhibit 2, which was a model used by salesmen in taking orders. This shows the commercial structure and it follows in close detail the disclosure and drawings of the patent in suit. This case, accordingly, differs from most patent cases in that the patent in suit discloses not only the principle of the invention but also the form which was accepted by the public and widely used.

Testimony of Mr. Murray for petitioners appearing on page 36 of the Record shows a very substantial business

in the structure shown by Plaintiffs' Exhibit 2 from 1929 to 1943. During those years petitioners' product here involved had built up a high reputation with the trade and its rights thereto had not been questioned. This is the first suit on this patent.

Respondent, hitherto unknown in this field, comes into the picture in this way. After Pearl Harbor industrial business in this ventilator ceased so far as new construction was concerned but a considerable business was developed for boats being converted by the government into aircraft carriers and for other governmental vessels. Petitioners, as a recognized and leading authority in this field, were asked by the government contractors to advise on questions of "weather protection, for blackout, and for ventilation on aircraft carriers", and sent, in April, 1941, an engineer to the Newport News Shipbuilding and Drydock Company for that purpose. The testimony as to this begins on page 39 of the Record, folio 117. As a result, ventilators such as those shown by petitioners' Exhibit 2 were standardized by the Navy Department. The standardization also covered other features of petitioners' product which are involved in the unfair competition part of this case but not in the question of patent infringement.

There followed considerable business with the various contractors for the Navy Department. This involved firms, such as the Bethlehem Shipbuilding Company and here in New York the Atlantic Basin Iron Works, Tietjen & Lang, the Navy Department at the Puget Sound Navy Yard in Bremerton, Oregon, and the Seattle-Tacoma Shipbuilding Company. Then in March 1942, petitioners submitted a quotation on an order to Ingalls Shipbuilding Corporation. Thereafter it was found that this order had been given to some other concern. Petitioners were told first it was a company at Toledo, Ohio, and after some difficulty found that it was the present respondent to whom this business had been given. (See pages 44, 45, and 46 of

the Record, folios 131-138.) Thereafter, petitioners found that respondent was issuing a catalog, printed in the Record at page 157, which copied closely some of the showings in petitioners' catalogs, pages 143 and 149 of the Record, and also followed closely some of petitioners' detailed drawings which had been submitted to and standardized by the Navy Department. Thereafter this suit was brought for unfair competition and patent infringement.

The unfair competition side of the case is based on respondent's showing in his catalog plans 502, 503 and 527.

The testimony for petitioners as to the relation between these plans and the showing of petitioners' catalog and blueprints from which they were appropriated by respondent appears as to plan 503 at pages 46 and 47 of the Record, as to plan 527 at pages 48 and 49 of the Record, and as to plan 502 at pages 51 and 52 of the Record.

Under such conditions petitioners were desirous of ascertaining how and why this concern, coming from nowhere so far as they were concerned, was showing in its catalog illustrations so closely resembling those of petitioners' catalogs as to tend to cause confusion to the public, tend to take away business from petitioners, and tend furthermore to injure petitioners' established reputation and standing with the trade and with the public by the use, in this way, of this material, by this respondent.

Interrogatories were submitted accordingly. In sworn answers to these interrogatories Fiedler made false and misleading statements. See interrogatory 12 and answer in the Record at page 163, and interrogatory 8 and answer in the Record at page 162.

This matter was finally cleared up and then only with much difficulty when respondent Fiedler was called as a witness by petitioners under the rule as to hostile witnesses.

It has already been noted that the Ingalls Shipbuilding Corporation order in connection with which respondent first came into this field dated from March, 1942. On the question of the date of petitioners' Exhibit 8, respondent's catalog, the witness initially would have us understand that this catalog was issued sometime in 1940. His testimony on this point begins at page 62 of the Record. He started with the date 1940, went from there to 1941, and finally ended up with 1942.

On the date of plan 502, Fiedler began with a date 1941 and ended up with "toward the end of 1941 or early part of 1942." (Record, page 63.)

As to plans 503 and 527, Fiedler gave the date as 1942, "probably April." (Record, page 64 and on.)

As to interrogatories 11 and 12 and the answers thereto, the Court's attention is called to the testimony of respondent Fiedler beginning on page 64 and continuing on down through page 67.

On page 66 the witness was questioned as to the answer to interrogatory 8 which said that George G. Sharp, Inc., so far as he knew had no connection with the supplying of ventilators to Ingalls Shipbuilding Corporation as admitted in paragraph 8 of respondent's Answer. The testimony beginning on page 66 going on down to page 68 shows that this sworn answer to the interrogatory was a deliberate misstatement of fact.

As to plan 503 on the question of original source of information, the witness's testimony is as follows:

Q. I am asking for the original source of information, so far as you are concerned, of what you show in your catalog as Plan 503? A. The original source of information?

Q. So far as you are concerned, where did you get the information? A. Do you want me to go through the entire procedure or just answer your question?

Q. Just answer my question. A. We got our information from the American Warming & Ventilating Company in the form of plans. (Record, page 69.)

The matter was finally summarized in the following testimony of respondent:

Q. In connection with these interrogatories, first I understood apparently that you were the source of this information because you said the draftsmen made the drawings and they made them in accordance with data furnished by you, and then I understood it comes from the American Warming & Ventilating, and I also understood that this was stock material, that you were just an innocent bystander, and that this material was furnished by American Warming & Ventilating Company just as a hardware store sells a keg of nails over the counter. This is correct is it not? A. I would say it is correct.

By the Court:

Q. You made all these answers, didn't you? A. Yes.

Q. That is what you said in so many words; that you bought this from the American Warming & Ventilating Company as you would buy a keg of nails from a hardware store? A. Not necessarily a keg of nails.

Q. Didn't you testify the other fellow did this work under your direction? A. The work I referred to was making the plans for our catalog.

Q. The tracing you mean. A. That is right. (Record, pages 74 and 75.)

It was only finally that we found that the source was "Either from the Ingalls Shipbuilding Corporation or George Sharp." (Record, page 70.)

It is clear accordingly that the respondent both in answers to sworn interrogatories and on the stand testified falsely under oath as to matters vital to the cause at issue and admitted finally that he had done so.

Under such conditions, the holding of the learned Judge of the District Court who had the opportunity of listening to this respondent on the stand was more than justified.

The Court's attention is called to all the Findings of Fact and Conclusions of Law of the District Court, appearing at page 206 of the Record, and especially to paragraph 4 thereof which we quote:

"4. The defendant deliberately appropriated plans which he knew were designed and originated by someone else. Even though he might have manufactured the article, if and when its manufacture was proposed to him, the reckless appropriation by him of another's plan and design as an advertising medium was a wrong to that other. He indulged himself in ingenious constructions of the interrogatories, and, although he admitted on the stand that he knew their purpose, he served answers that were disingenuous and misleading. These acts, coupled with the manner and matter of his testimony, constitutes unclean hands."

Reasons Relied Upon for Allowance of the Writ.

The District Court found as a fact on the question of unfair competition:

"2. The defendant appropriated and published in his catalog three plans of the plaintiffs which he found in Navy specifications. He recognized that the work in the shipyards was Navy work. The uncontradicted evidence of the plaintiff shows and I find as a

fact that the form and certain characteristics of the plans marked them as the plaintiffs' and that the trade would recognize them as originating with either of the plaintiffs who are both well known in the trade. I further find that plaintiffs' contribution of the plan to the United States Navy was for the specific purpose of war and was not intended to and did not constitute a relinquishment of its rights thereto and therein."

The Circuit Court of Appeals, Second Circuit, following its quotation of this Finding of Fact of the Court below holds:

"Had these drawings of the plaintiffs so 'appropriated' been copyrighted we will assume, *arguendo*, that their use by the defendant would have been a legal wrong to the plaintiffs but that kind of a tort has not been proved since there was no copyright."

The Circuit Court of Appeals then goes on to hold that petitioners have not been legally wronged by respondent's use of such drawings, and again says:

"Moreover, there was nothing about these drawings to indicate the plaintiffs as the source of them except the fact that they were accurate drawings of articles known to the trade to be manufactured and sold by the plaintiffs.

.

. . . unfair competition was not shown merely by the copying of the uncopyrighted drawings the plaintiffs had made but had no exclusive right to use. Such copying is not unfair competition unless the drawings had acquired a secondary meaning which marked the product they depicted as that of the plaintiffs in such a way that what the defendant sold would be bought as the goods of the plaintiffs."

The Circuit Court of Appeals cites three cases, *James Heddon's Sons v. Millsite Steel & Wire Works*, 128 F. (2) 6; *Electric Auto-Lite Co. v. P. & D. Mfg. Co.*, 2 Cir. 109 F. (2) 566; *Lewis v. Vendome Bags*, 2 Cir., 108 F. (2) 16, 18. None of these cases, however, either as to the facts upon which they rest or the opinions which they present in any way bear upon the facts of this case as already shown to this Court.

The Circuit Court of Appeals is here accordingly making new law not in conformity with the established holdings of its own Court and not in conformity with the established interpretation of the law in various other Circuit Courts of Appeal.

We have here accordingly the advancing of a new and as we submit unsound and unwise interpretation of the law which should in and of itself demand review by this Court and also specially demands review by this Court since it is contrary in letter and in spirit to the holding of other Circuit Courts of Appeal. As to the holding of other Circuit Courts of Appeal, for brevity we will cite only that of the Circuit Court of the 7th Circuit in *Sinko et al. v. Snow-Craggs Corp.*, 105 F. (2) 450. This opinion considers both sides of the question of functional and non-functional characteristics and holds:

"The law of unfair competition stresses business integrity, encourages legitimate trading, and protects good will against spoilation." (Page 452.)

And again:

"The existence of a right of action depends upon the peculiar facts of each case, turning on whether what is done by one person to get the business of another is done unfairly, i. e., by means that involve fraud or deceit.

In other words, equity will protect the honest, and restrain the dishonest, trader." (Page 452.)

In the *Sinko* case the final holding was against the plaintiff but that even makes more important the statement of general principles of the law directly applicable here, directly contrary to the present holding of the Circuit Court of Appeals, 2nd Circuit, in this case, and accordingly calls more insistently for a review of this holding in this case by this Court.

On the question of prior ruling in the Circuit Court of Appeals for the 2nd Circuit, it should be sufficient to cite *Steiff v. Bing*, 215 Fed. 204, in which Judge Hough, then sitting at District, afterwards one of the great judges of the 2nd Circuit Court of Appeals, held at page 206,

"'Unfair Competition' consists in selling goods by means which shock judicial sensibilities; and the Second Circuit has long been very sensitive."

It appears that the 2nd Circuit, or at least those of its judges who concurred in the ruling in this case below are no longer thus sensitive and it is submitted confidently that this Court should review this holding in order that a sound and consistent principle may be indicated for our District and Circuit Courts throughout.

A petition for rehearing of the holding of the Circuit Court of Appeals in this case was filed on February 13, 1945 and it obviously caused some discussion and comment in the Circuit Court since it was not denied until March 16, 1945, the record then showing: "Per Curiam: Petition for rehearing denied. H. B. C., C. E. C., J. N. F., U. S. C. JJ."

The rule is that petition for rehearing cannot be granted unless "a judge who concurred in the judgment desires it and the majority of the Court so determines." The case

would not have been held so long if there had not been a difference of opinion.

On the patent side of the case we rely for allowance of the writ primarily on the fact that the reliance of the Court below for holding the claims of the patent in suit invalid was mainly on the ruling of this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, and the fact that that ruling of this Court is variously interpreted in various courts of the country, and has caused confusion and uncertainty in the application of the patent law by the courts, both district and circuit, to such an extent that there is imperatively demanded in the public interest, a ruling by this Court which will quiet this confusion and advise the various subordinate courts as to the position of this Court on this vexing point.

We quote from the *Cuno Engineering* case,

"That is to say the new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain."

We cite *Picard v. United Aircraft Corp.*, 128 F. (2) 632 in which the Circuit Court of Appeals for the 2nd Circuit held:

"... We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize 'a pronounced new doctrinal trend' which it is our 'duty, cautiously to be sure, to follow not to resist.' *Perkins v. Endicott Johnson Corp.*, 2 Cir., 128 F. (2) 208. We hold that the claims in suit are invalid for lack of invention."

We cite *Sbicca-Del Mac, Inc., et al. v. Milius Shoe Co.*, 145 F. (2) 389, 8th Circuit. We call the attention of this Court particularly to that part of the opinion on page 394 which discusses *Hotchkiss v. Greenwood*, *McClaim v. Ort-mayer*, the *Cuno Engineering* case, the *Picard* case, and *In Re Shortell*, and concludes:

“invention what constitutes the ‘flash of genius’, that is, ‘more’ than the ‘skill of an ordinary mechanic acquainted with the business’, must still be determined without the aid of any statutory or judicial definition in each particular case, and sometimes by judges without ordinary skill in the particular art.”

In this case the ruling of the District Court of invalidity was reversed and the patent held valid.

On the question of confusion and uncertainty in the courts below as to the “flash of genius” holding of this Court, we cite further *Chicago Steel Foundry Co. v. Burn-side Steel Foundry Co.*, 132 F. (2) 312, Circuit Court of Appeals for the 7th Circuit, January 20, 1943, rehearing denied February 10, 1943. In this case the ruling of the District Judge holding the patent invalid was reversed and we quote:

“We could perhaps successfully wrestle (as we have with other tests) with the definition of the word ‘genius’ and even apply its definition. But the restrictions which rise from the use of the phrase ‘flash of genius’ make the test more baffling in its uncertainty and exclude the larger portion of those whose products have heretofore been understood as the work of an inventor.

• • • • •

"The test of a 'flash of genius' should be rejected not only because it is incapable of acceptable definition but because it injects into the statute something not appearing therein. The Federal decisions covering a century contain many to the effect that it is the fact of accomplishment,—novelty appearing, rather than the method of accomplishment with which judicial inquiry is concerned."

We cite further *In Re Shortell*, 142 F. (2) 292, decided by the United States Court of Customs and Patent Appeals on April 4, 1944, and quote:

"(5) Much controversy has arisen concerning the interpretation of certain language in the case of *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 534, O. G. 699, wherein, following the citation of a number of cases, the court said:

• • • That is to say, the new device, however useful it may be, must reveal the flash of genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain.

It is interesting to note that all of the cases cited by the court preceding the above quotation were decided upon the familiar basis of whether the thing patented involved more than the skill of the art involved. In view of this fact, we are of the opinion that the use of the term 'flash of creative genius,' above quoted, was intended to mean nothing more than that the thing patented must involve more than the skill of the art to which it relates.

(6) In the case of *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 52 U. S. P. Q. 563, the court said:

We cannot, moreover ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize 'a pronounced new doctrinal trend' which it is our 'duty, cautiously to be sure, to follow, not to resist.'

While recognizing, of course, that it is the duty of this court to follow the law as declared by the Supreme Court, we do not conceive it to be our duty to change our basis of decision merely because some courts assume that there is a 'new doctrinal trend' with regard to the standards required for invention."

As an additional and controlling reason why certiorari should be granted in this case and the views of this should be granted in this case and the views of this Court again stated as to what the courts below, the bar, and the public, vitally interested in questions affecting our patent system, are to understand as to the ruling of this Court in the *Cuno* case, we cite the fact, which we take it must, in many instances at least, have come through to the notice of the justices of this Court even in their high and to a certain extent isolated position, that the courts below generally feel that this Court is, as a matter of fixed policy, adverse to any ruling giving a patentee his constitutional monopoly under a patent. That this Court is against the patent system and that accordingly, even if the court should feel that a meritorious patent were involved, there is no use in sending it up with a holding of validity. That may well account for the reason why the District Court in this case, amply impressed by the position of petitioners and its equitable claim to the Court's consideration, held on the patent side that infringement had not been "satisfactorily proved."

This feeling as to the attitude of this Court toward patents is also quite prevalent in the industrial world.

Men engaged in legitimate business feel that for the present at least it is futile to promote developments in industry and attempt to rely upon patent protection for meritorious advances in an art. Others, like this respondent, of questionable character, feel that they can pirate another man's business and another man's patented improvements with impunity in view of the fact, which seems to them fixed, that the patent system of the United States under the rules of this Court is practically becoming a thing of the past, and that the rule now is not that of promoting the progress of science and the useful arts, but is "the good old rule, the ancient plan, that they shall take, who have the power, and they shall keep who can."

We submit that this very definite feeling, in the Courts, among lawyers, and in industry, as to what was meant by this Court's reference to a flash of genius in the *Cuno Engineering* case is an unsound and unwarranted interpretation of the language of that case.

Genius, of course, may be variously defined. To some it means a high quality of spirit and the ability to translate that spiritual elevation into substance or words which has characterized the relatively very few great poets, painters, and sculptors.

Another definition makes genius an infinite capacity for taking pains.

Another definition holds that genius involves a spiritual or mental soaring above the heads of the multitude and the development of something which could not be developed by the multitude itself, but which, having been developed by a genius, aids in the spiritual, mental or otherwise uplifting of the multitude.

We think that the ruling of the Court of Customs and Patent Appeals in *Re Goessling*, 108 F. (2) 266, is quite properly in accordance with the letter and the spirit of the *Cuno* case when it says:

“ . . . The patent laws do not contemplate that every improvement, even though of great utility, should warrant the improver being given a monopoly upon the manufacture and sale of the same. One entitled to a patent must not only obtain novel and useful results, but his device must be the result of inventive genius.”

On the specific question involved in this case as to the patentability of the patent in suit and of the structure shown by petitioners' Exhibit 2, we rely confidently on the late ruling of this Court in *Universal Oil Products Co. v. Globe Oil Refining Co.*, 137 F. (2) 3, decided May 29, 1944, in which the Court held:

“ . . . Retrospective simplicity is often a misleading test of invention where it appears that the patentee's conception in fact solved a recognized problem that had baffled the contemporary art;”

On the question of validity, the Circuit Court held in this case:

“Both the first two claims which are directed to the structure of the frame and the last two covering the mechanism for operating the louvers deal only with minor changes from the prior art which were plainly so obvious and within the skill of an ordinary designer of the well known louver type ventilator that there was no invention in making them. The plaintiff failed to introduce any evidence of invention to support the presumption flowing from the grant of the patent and that was overcome decisively by the defendant's evidence.”

The fact is that the petitioner, in addition to the presumption flowing from the grant of the patent, intro-

duced evidence as to the business which it has done under patent since 1929, the acceptance of this product in the trade, and its saving in building construction, amounting to \$12,600, for illustration, in the case of the Half Moon Hotel on Long Island, bottom of page 37 of the Record.

This is certainly evidence of facts tending to support the presumption flowing from the grant of the patent and quite in addition to such presumption. The fact is furthermore although it is ignored by the Court in its statement as to the presumption flowing from the grant of the patent being "overcome decisively by the defendant's evidence", that there was no evidence whatsoever introduced by the defendant in any way challenging, limiting, qualifying, or otherwise effecting this evidence.

No evidence whatsoever was introduced by defendant as to the state of the prior art or anything bearing on the question of invention, save solely the testimony of Goodman J. Harris, an employee of defendant who had been in the employ of defendant for about three and one-half months, who had been familiar with this art only since his employment with the defendant, as he admits in his statement, folio 296, page 99 of the Record, and who testified only as to patents introduced on behalf of defendant. This is clearly not evidence which in way qualifies or overcomes the facts as to the evidence of invention supporting the grant of the patent, flowing from the effect of the patented invention upon the trade, its acceptance by the trade, its recognition by the trade, its importance to the trade, its saving of cost in building construction, and the amount of business done thereunder by plaintiffs.

On validity the Circuit Court below held further:

"As to the invalidity of claims 1 and 2 there is little need to go further into the prior art than to the

patentee's previous patent No. 1,519,553 over which the patent in suit was said in the specifications to be an improvement. There we find disclosed all the claimed novel features of the patent in suit except the change from flanges all directed inwardly to the direction outwardly of the flanges on two of the members."

The Court's holding in this respect is based on error of fact. Taking for example claim 1, the Riker patent No. 1,519,553 does not show the frame having opposite channel pieces having their marginal portions extending inwardly of the frame, opposite channel pieces having their marginal portions extending outwardly of the frame, which is part of the claimed novel combination. Nor does it show outer faces of adjacent flanges of the frame being flush with each other. It should be sufficient to note that the earlier Riker patent No. 1,519,533, which was an earlier unsuccessful attempt to improve the art, does not show the claimed combination or anything which can accomplish the objects of the claimed combination, in view of the showing, supporting the grant of the patent, as to the effect of the claimed combination exactly as shown and described in the patent in suit, its recognition by the commercial art and its importance to, and advantages in, the commercial art.

And yet this Court calls the distinct differences in the combination as a whole as compared with the earlier unsuccessful Riker patent No. 1,519,553 "this little change". On this record it was the final step to success, even if it were a "little change", but it was not a "little change". It was an entire reconstruction involving the making of a new combination with new parts and new results, both theoretically and practically as shown by the evidence.

It is submitted that on the record herein, the structure disclosed in the patent in suit, which has stood the test of time over a period of more than fifteen years, which was not in the prior art and which has not been superseded by anything later developed by this crowded air conditioning art, should be held to answer the highest test of patentable invention, and as such to embody a real flash of inventive genius.

This invention shows decidedly something over and beyond what was produced, or could have been produced, by the ordinary worker using the ordinary skill of the art, and something over and beyond what the workers skilled in the art or the inventors in the art have been able to produce since that time, since nothing has taken its place. If this be not genius then genius has no relation to the work-a-day affairs of life, but must rest upon some ectoplasmic or other force beyond the present known limits of thought or achievement, something in the nature of the indicated even root of a negative quantity.

The Circuit Court made a holding on the question of infringement in the following language:

“Both the claims in suit embody the inward deflection of the ends of the top and bottom members to fit between the flanges of the other members. The defendant does not do that in the butt-welder construction it employs and so the finding of non-infringement was clearly right.”

This was, however, just thrown in and should not affect the question of the allowance of this writ because it is obviously incorrect as to claim 1 at least. It is true that claim 2 calls for “flange offset portions” which is what the Circuit Court means by “inward deflection of the top and bottom members.”

Claim 1, however, does not call for this inward deflection of the top and bottom members but specifies only "the outer faces of adjacent flanges of the frame being flush with each other." This is exactly what respondent does in the butt-welder construction referred to by the Circuit Court, and the holding of the Circuit Court on this point is accordingly clearly in error and may be disregarded by this Court up to the point where it may be very briefly disposed of if this writ is allowed.

Conclusion.

It is in the public interest that this Court should decide that, under circumstances such as those of this case, the law of unfair competition will protect petitioners against the invasion of their rights by respondent.

It is in the public interest that this Court should decide whether what was done by the patentee in developing the structure of the patent in suit does not constitute a worthy example of creative inventive genius to be protected as such.

It is strongly in the public interest that this Court should end the conflict, confusion, and uncertainty, which now prevails in the Courts below, and throughout the public generally, as to the correct interpretation of the criterion of patentable invention enunciated by this Court in the *Cuno Engineering* case; and the case at bar presents a favorable opportunity for such action.

It is not believed necessary to add to the statement of facts herein anything in the nature of an argumentative brief and no supporting brief will be filed.

In the interest of brevity, petitioners at this time do not set forth all of the points which will be urged at the argument on the merits of this cause should the writ be

granted, nor all of the contentions in support of such points; but, in order to comply with the rule of this Court requiring that all issues upon which decision is requested be presented in the petition for certiorari, petitioners here refer to and incorporate into this petition all of the matters presented in the petition for rehearing before the United States Circuit Court of Appeals for the Second Circuit, printed in the additional volume of the record herein, with the same force and effect as if herein set out in full.

WHEREFORE your petitioners respectfully pray that a writ of certiorari be issued out of and under the seal of this Honorable Court directed to the United States Circuit Court of Appeals for the Second Circuit, commanding that court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a transcript of the record and proceedings herein; and that the judgment decreed under the mandate of the said Circuit Court of Appeals for the Second Circuit herein be reversed by this Honorable Court and that the case be remanded with instructions that respondent was guilty of unfair competition, that the patent in suit was valid and was infringed by respondent, that judgment be entered accordingly, and that your petitioners have such other and further relief in the premises as to this Honorable Court may seem meet and just.

FREDERIC P. WARFIELD,
GEORGE H. BRADDOCK,
Counsel for Petitioners.

New York, N. Y.
June 18, 1945



(7)

FILED

JUL 28 1945

CHARLES ELMORE CRO
CLERK

Supreme Court of the United States

October Term, 1945.

No. 148.

THE AIROLITE COMPANY and THE
VENTILOUVRE COMPANY, INC.,
Petitioners,

AGAINST

HARRY W. FIEDLER, doing business as AIR
CONDITIONING UTILITIES COMPANY,
Respondent.

Brief for Respondent in Opposition to Petition for
Writ of Certiorari.

FREDERICK BREITENFELD,
J. PRESTON SWECKER,
Counsel for Respondent.



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Supreme Court of the United States

OCTOBER TERM, 1945.

THE AIROLITE COMPANY and THE
VENTILOUVRE COMPANY, INC.,
Petitioners,

AGAINST

HARRY W. FIEDLER, doing business
as AIR CONDITIONING UTILITIES
COMPANY,
Respondent.

No. 148.

Brief for Respondent in Opposition to Petition for Writ of Certiorari.

This is an ordinary suit for patent infringement and unfair competition. There is no diversity of decisions; there is no public interest involved; and no novel question of law is presented.

The Alleged Patent Infringement.

The single patent in suit is No. 1,722,059, issued July 23, 1929 to one Andrew L. Riker and now owned by Petitioner The Airolite Company. It relates to a structure of well-known and purely mechanical character, comprising a rectangular frame and a series of louvers which are pivotally mounted for selective adjustment into "closed" and "open" positions. Each of the four claims of the patent is directed to minor structural details, claims 1 and 2 relating solely to the rectangular frame itself, claims 3

and 4 relating solely to an insignificant detail of the operating handle (Figures 8 and 9 of the patent) by means of which the louvers are pivotally adjusted.

Prior to trial, Petitioners withdrew their charge of infringement of claims 3 and 4.

Respondent set up the usual defenses of non-infringement and invalidity, and on the question of invalidity Respondent filed a counterclaim seeking a declaratory judgment (28 U. S. C. 400) to the effect that all four claims of the patent are invalid for lack of invention.

The trial Court held there was no infringement of claims 1 and 2, and declined to pass on the question of invalidity of any of the claims.

The Circuit Court of Appeals properly affirmed the judgment as to non-infringement, and held in addition that each of the claims is invalid for lack of invention, stating:

“Both the first two claims which are directed to the structure of the frame and the last two covering the mechanism for operating the louvers deal only with minor changes from the prior art which were plainly so obvious and within the skill of an ordinary designer of the well known louver type ventilator that there was no invention in making them. The plaintiff failed to introduce any evidence of invention to support the presumption flowing from the grant of the patent and that was overcome decisively by the defendant’s evidence.”

The Circuit Court of Appeals subsequently denied Petitioners’ application for rehearing.

There is nothing unusual in the facts involved, nor in the defenses set up by Respondent, nor in the proper ruling of both the Trial and Appellate Courts that Respond-

ent has not infringed, nor in the ruling of the Appellate Court that the claims of the patent are invalid.

"Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent." *Keller v. Adams-Campbell Co.*, 264 U. S. 314.

The Alleged Unfair Competition.

This charge is based solely on the allegation that certain specified illustrations in Petitioners' catalogues (designated "Detail 675", "Detail 45" and "Detail 170"; R. pp. 11, 12, 13) were copied by the Respondent and used by him in his catalogue (designated, respectively, Plans 502, 503 and 527, R. pp. 158, 159, 160). See Complaint, paragraphs 9 and 10 (R. pp. 4, 5) and Bill of Particulars, paragraph 4(b) (R. p. 10).

Respondent denied this charge and has consistently stressed that a mere comparison of Petitioners' illustrations with the alleged copies substantiates his contention that the charge of copying is unfounded.

The Circuit Court of Appeals sustained Respondent, holding that even if Petitioners' illustrations *had* been copied, no cause of action would have arisen. Neither the Petitioners' illustrations themselves, nor the catalogues in which they were published by Petitioners, are copyrighted; the articles depicted by the illustrations are unpatented, and are composed of well known structural elements freely usable by anyone; and the appearance of the products has acquired no secondary meaning.

The Circuit Court of Appeals said:

"The defendant sold ventilators, not plans. At the most all he did was to sell ventilators repre-

sented as his own in his own catalogue but illustrated by means of plans the trade would recognize as being plans made by the plaintiffs. We do not stop to consider whether, as the appellant contends, this finding lacked adequate support in the evidence for, if pushed to its extreme, it shows no more than that the defendant represented that he made and sold ventilators which were built according to the plans of the plaintiffs as he had the lawful right to do."

There is nothing unusual in the facts involved, and the ruling of the Circuit Court of Appeals was based upon well-established principles of law. Petitioners' charge of unfair competition was found by the Appellate Court to be wholly without merit, and was properly dismissed with costs.

Conclusion.

The ruling of the Court below is not in conflict with any decision of this Court, nor with any decision of any other Circuit Court of Appeals.

The case involves no principle whose settlement is of importance to the public.

The granting of a writ of certiorari is not warranted merely to review evidence or inferences drawn from it. *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175.

The Petition is without merit and should be denied.

Respectfully submitted,

FREDERICK BREITENFELD,
J. PRESTON SWECKER,
Counsel for Respondent.

